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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,320	07/06/2000	Richard J. Collins	16762-85-US01	6426

26853 7590 01/30/2004
COVINGTON & BURLING
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WASHINGTON, DC 20004-2401

EXAMINER

FRIDIE JR, WILLMON

ART UNIT PAPER NUMBER

3722

DATE MAILED: 01/30/2004

24

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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 23

Application Number: 09/611,320
Filing Date: July 06, 2000
Appellant(s): COLLINS ET AL.

Covington and Burling
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/30/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims s 24-33 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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4443027	McNeely	4-1984
Wo 93/11510	Preddy	6-1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 24,25 and 27 stand rejected under 35 U.S.C. 102(b) as being anticipated by WO ('510).

WO ('510) discloses all of the subject matter as set forth in the claims and is identical to the invention as broadly recited. Some of the claimed elements clearly disclosed by the reference are; a tread (14) having a lip and crater; and a magnetic stripe.

Claims 26 and 29-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO ('510).

In regard to claims 26, it would have been an obvious matter of design choice to form the stripe in the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CPA 1955).

In regard to claims 29,32 and 33, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the treads in the claimed locations, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regard 30 and 31, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the craters in the claimed arrangement, since it has been

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held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO ('510) as applied to claims 26 and 29-33 above, and further in view of McNeely.

WO ('510) discloses the claimed invention except for an embedded computer chip. McNeely teaches that it is well known in the art to use an embedded computer chip in a card assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide WO ('510) with an embedded computer chip in the manner as taught by McNeely in order to increase the information storage capacity of the assembly.

(11) Response to Argument


Appellant argue that the WO ('510) reference does not disclose any "crater" structure, but simply a card wherein a lengthwise ridge has both a projected portion and a recessed portion. The examiner submits that WO ('510) anticipates claims 24,25 and 27 as broadly recited. The assembly of WO ('510) clearly has formed therein a tread (14) having a lip and crater; and a magnetic stripe. Further the examiner submits that the WO ('510) reference is analogous art and it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, WO ('510) definitely defines a credit card sized card and the tread lip and crater formed therein inherently provide a gripping surface for the user.

Appellant states that it appears that the WO('510) device would be typically used as "keys" for door locks in hotels and the like. The examiner submits that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Again, WO ('510) clearly discloses a credit card sized card and the tread lip and crater formed therein inherently provide a gripping surface for the user.

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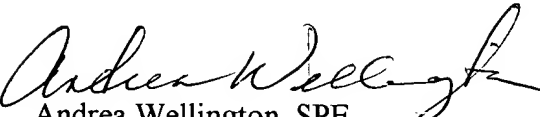
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Willmon Fridie, Jr.
Primary Examiner
Art Unit 3722

December 15, 2003

Conferees


Andrea Wellington, SPE


Derris Banks, SPE

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